

Application Number 10/730,878
Response to Office Action mailed January 3, 2006

REMARKS

This submission is responsive to the Office Action dated January 3, 2006. Applicant has not amended the claims by way of this submission. Claims 1-14 remain pending.

Claim Rejections Under 35 U.S.C. §§ 102 and 103

In the Office Action, the Examiner rejected claims 1-7, 9, 10, 13 and 14 under 35 U.S.C. § 102(b)¹ as being anticipated by US 6,480,743 to Kirkpatrick et al. (Kirkpatrick). The Examiner also rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Kirkpatrick, and claims 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Kirkpatrick in view of US 6,671,544 to Baudino. Applicant respectfully traverses these rejections. Kirkpatrick fails to disclose each and every feature of the claimed invention, as required by 35 U.S.C. § 102, and neither Kirkpatrick nor Baudino provides any teaching that would have suggested the desirability of modification to include such features, as required by 35 U.S.C. § 103.

For example, Kirkpatrick fails to disclose or suggest an implantable medical device comprising an overmold that at least partially encapsulates each of at least two housings, as required by independent claim 1. In the Office Action, the Examiner argued that the housing 226 depicted in FIG. 2 of Kirkpatrick containing the CPU 428 and Power Supply 432 depicted in FIG. 4 of Kirkpatrick meets this requirement. Applicant disputes that housing 226 is an overmold within the meaning of claim 1. Moreover, even if the Examiner's mischaracterization of housing 226 were correct, the arrangement of the components of the Kirkpatrick device identified by the Examiner does not anticipate the above-identified requirement of claim 1.

In particular, Kirkpatrick does not disclose or suggest that the CPU 428 and Power Supply 432 include respective housings within the housing 226. Again, claim 1 requires an overmold that at least partially encapsulates each of at least two housings. CPU 428 and Power Supply 432 are merely depicted in FIG. 4 as functional modules in a functional block diagram. Kirkpatrick provides no teaching regarding the structure of these functional modules, much less suggests that these functional modules include respective housings when located within housing 226. Further, Baudino provides no teaching relevant to this requirement of independent claim 1.

¹ Kirkpatrick issued on November 12, 2002. The present application claims the benefit of a number of provisional applications filed prior to November 12, 2003. Therefore, Applicant respectfully suggests that Kirkpatrick is not prior art for the present application under section 102(b).

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As another example, like independent claim 1, independent claim 9 requires an overmold and a plurality of housings. For the reasons stated above with respect to claim 1, the applied references fail to disclose or suggest this requirement of claim 9

Independent claim 9 also requires a lead connection module deployed within the overmold. The applied references fail to disclose or suggest this requirement of claim 9. In rejecting claims 1 and 9, the Examiner argued that the housing 226 and lead connector 220 depicted in FIG. 2 of Kirkpatrick are an overmold and lead connection module within the meaning of the claims. However, FIG. 2 clearly depicts the lead connector 220 as being located on the exterior of the housing 226, directly contrary to the above-identified requirement of independent claim 9.²

In rejecting claim 9, the Examiner stated "the lead connector of both Kirkpatrick and the claimed invention act to physically secure the lead to the device and facilitate electrical connection in a substantially fluid-tight environment with biocompatible, non-elastomeric or elastomeric materials." However, contrary to the Examiner's statement Kirkpatrick does not even mention elastomeric materials. Moreover, even if the Examiner's characterization of the Kirkpatrick device were correct regarding the functionality of the lead connector, this argument is irrelevant insofar as Kirkpatrick fails to suggest the lead connection module deployed within the overmold, as required by claim 9.

Applicant respectfully reminds the Examiner that, in order to support an anticipation rejection under 35 U.S.C. § 102, it is well established that a prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule."³ If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. § 102 is improper.⁴ In other words, the Examiner can only "consider" Kirkpatrick to anticipate independent claim 9 if it discloses each and every element of claim 9. Again, Kirkpatrick fails to disclose or suggest a lead connection module deployed within the overmold, as required by claim 9.

² See also Kirkpatrick, col. 9, ll. 16-19.

³ See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

⁴ *Id.* See also *Lewmar Marine, Inc. v. Barient, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (CAFC 1998); *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).

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Claim 13 further requires that the lead connection module is deployed within a first material of the overmold that holds at least part of the housing of one of the modules. The material that the Examiner has identified as being configured to hold at least part of a module is the titanium or other material of housing 226. Again, FIG. 2 clearly depicts lead connector 220 as being located on the exterior of housing 226, directly contrary to this requirement of claim 13. Accordingly, Kirkpatrick fails to disclose or suggest the requirements of claim 13.

Baudino is cited by the Examiner merely for its mention of elastomeric and silicone materials in the context of a medical lead, and provides no teaching that would overcome the deficiencies of Kirkpatrick with respect to the requirements of claims 9 and 13. In particular, Baudino does not disclose or suggest a lead connection module deployed within an overmold that holds at least part of a housing. Furthermore, the teaching of Baudino with regard to elastomeric and silicone materials would provide nothing to suggest that such materials could be used in an overmold, as recited by Applicant's claims

Applicant reserves further comment with respect to Baudino, but notes that this reference clearly lacks any teaching that would remedy the basic deficiencies of Kirkpatrick outlined above.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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